

Interview Summary

Application No.

09/654,939

Applicant(s)

JO ET AL.

Examiner

Brian P. Werner

Art Unit

2621

All participants (applicant, applicant's representative, PTO personnel):

(1) Brian P. Werner (primary examiner).

(3) _____

(2) Alan Kasper (applicant's rep.).

(4) _____

Date of Interview: 5/5/04

Type: a) ☒ Telephonic b) ☐ Video Conference
c) ☒ Personal [copy given to: 1) ☐ applicant

2) ☒ applicant's representative] w/paper # 14

Exhibit shown or demonstration conducted: d) ☐ Yes

e) ☒ No.

If Yes, brief description: _____

Claim(s) discussed: N/A

Identification of prior art discussed: N/A

Agreement with respect to the claims f) ☐ was reached. g) ☐ was not reached. h) ☒ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: _____

The attachment was faxed to applicant's rep on 5/5/04. The examiner stated that recapture would no longer be pursued.

THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE, OR THE MAILING DATE OF THIS INTERVIEW SUMMARY FORM, WHICHEVER IS LATER, TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.

Examiner's signature, if required

Summary of Record of Interview Requirements

Manual of Patent Examining Procedure (MPEP), Section 713.04, Substance of Interview Must be Made of Record

A complete written statement as to the substance of any face-to-face, video conference, or telephone interview with regard to an application must be made of record in the application whether or not an agreement with the examiner was reached at the interview.

Title 37 Code of Federal Regulations (CFR) § 1.133 Interviews

Paragraph (b)

In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office action as specified in §§ 1.111, 1.135. (35 U.S.C. 132)

37 CFR §1.2 Business to be transacted in writing.

All business with the Patent or Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

The action of the Patent and Trademark Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through the failure to record the substance of interviews.

It is the responsibility of the applicant or the attorney or agent to make the substance of an interview of record in the application file, unless the examiner indicates he or she will do so. It is the examiner's responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability.

Examiners must complete an Interview Summary Form for each interview held where a matter of substance has been discussed during the interview by checking the appropriate boxes and filling in the blanks. Discussions regarding only procedural matters, directed solely to restriction requirements for which interview recordation is otherwise provided for in Section 812.01 of the Manual of Patent Examining Procedure, or pointing out typographical errors or unreadable script in Office actions or the like, are excluded from the interview recordation procedures below. Where the substance of an interview is completely recorded in an Examiners Amendment, no separate Interview Summary Record is required.

The Interview Summary Form shall be given an appropriate Paper No., placed in the right hand portion of the file, and listed on the "Contents" section of the file wrapper. In a personal interview, a duplicate of the Form is given to the applicant (or attorney or agent) at the conclusion of the interview. In the case of a telephone or video-conference interview, the copy is mailed to the applicant's correspondence address either with or prior to the next official communication. If additional correspondence from the examiner is not likely before an allowance or if other circumstances dictate, the Form should be mailed promptly after the interview rather than with the next official communication.

The Form provides for recordation of the following information:

- Application Number (Series Code and Serial Number)
- Name of applicant
- Name of examiner
- Date of interview
- Type of interview (telephonic, video-conference, or personal)
- Name of participant(s) (applicant, attorney or agent, examiner, other PTO personnel, etc.)
- An indication whether or not an exhibit was shown or a demonstration conducted
- An identification of the specific prior art discussed
- An indication whether an agreement was reached and if so, a description of the general nature of the agreement (may be by attachment of a copy of amendments or claims agreed as being allowable). Note: Agreement as to allowability is tentative and does not restrict further action by the examiner to the contrary.
- The signature of the examiner who conducted the interview (if Form is not an attachment to a signed Office action)

It is desirable that the examiner orally remind the applicant of his or her obligation to record the substance of the interview of each case. It should be noted, however, that the Interview Summary Form will not normally be considered a complete and proper recordation of the interview unless it includes, or is supplemented by the applicant or the examiner to include, all of the applicable items required below concerning the substance of the interview.

A complete and proper recordation of the substance of any interview should include at least the following applicable items:

- 1) A brief description of the nature of any exhibit shown or any demonstration conducted,
- 2) an identification of the claims discussed,
- 3) an identification of the specific prior art discussed,
- 4) an identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary Form completed by the Examiner,
- 5) a brief identification of the general thrust of the principal arguments presented to the examiner,
(The identification of arguments need not be lengthy or elaborate. A verbatim or highly detailed description of the arguments is not required. The identification of the arguments is sufficient if the general nature or thrust of the principal arguments made to the examiner can be understood in the context of the application file. Of course, the applicant may desire to emphasize and fully describe those arguments which he or she feels were or might be persuasive to the examiner.)
- 6) a general indication of any other pertinent matters discussed, and
- 7) if appropriate, the general results or outcome of the interview unless already described in the Interview Summary Form completed by the examiner.

Examiners are expected to carefully review the applicant's record of the substance of an interview. If the record is not complete and accurate, the examiner will give the applicant an extendable one month time period to correct the record.

Examiner to Check for Accuracy

If the claims are allowable for other reasons of record, the examiner should send a letter setting forth the examiner's version of the statement attributed to him or her. If the record is complete and accurate, the examiner should place the indication, "Interview Record OK" on the paper recording the substance of the interview along with the date and the examiner's initials.

**Attachment to Interview Summary
Paper No. 13**

Upon review of the file history for the upcoming personal interview scheduled for the 12th of May, 200, and in consideration of the Office Memorandum titled Updated Guidelines as to Applying the Recapture Rule to Reissue Applications (August 4, 2003 – referred to below as the “Guidelines”), the examiner will no longer pursue the previous 35 U.S.C. 251 (recapture) rejections detailed in paragraph 4 of the final Office Action (paper no. 12). However, the prior art rejections in the final action are maintained. An explanation pertaining to recapture shall follow.

The Guidelines (the pertinent pages of which are attached hereto) will be incorporated into the next revision of the MPEP (chapter 1400), and thus are considered Office Policy. They serve to clarify the test for the presence of recapture or lack thereof, and address the ramifications of *Pannu*, *Eggert* and *Yamaguchi* decisions with respect to the test.

Regarding the Patent application (08/495,591 – the grandparent application to the instant reissue), it is noted that independent claims were presented that were directed to encoding and decoding methods. Independent claim 1 of the Patent file was directed to encoding (or “coding”), and the claims of the instant reissue application are also directed to encoding. Thus, the subject matter of the instant reissue application is related to the subject matter defined by claim 1 (and its dependent claims) of the Patent application.

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Turning to the prosecution history of the Patent file (i.e., the original prosecution), it is clear that a single mutually-agreed-upon action resulted in allowability. That is, following a telephone interview detailed in paper number 10 of the Patent file, the applicant filed amendment C canceling dependent claim 2 of the Patent file and incorporating all of its limitations to independent claim 1 as follows (referred to below as the "added subject matter"):

" , wherein said selecting step has the selecting range of a plurality of variable-length coding tables having different patterns of a regular region and an escape region according to said intra/inter mode information of the currently processed block."

Following the amendment, the examiner allowed the claims of the Patent file.

It is clear now that the arguments presented to the Patent file examiner pertaining to subject matter other than the added subject matter were not convincing to the examiner, and that it was the added subject matter (quoted above) alone that resulted in allowance.

Now turning to the reissue claims, and specifically to reissue claim 8, the applicant has retained a broader version of the added subject matter in the following form (at lines 6-7 of the claim as presented in amendment B of the instant application):

"... wherein said selecting step has the selecting range of a plurality of variable-length coding tables ..."

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Thus, the situation of reissue claim 8 is one where the claim is broader in aspects not related to the added subject matter. Further, the added subject matter (i.e., that caused the allowance) is retained, albeit in a broadened form. Recapture is not barred in this situation.

The Guidelines state (page 2, attached hereto) that an entire omission of any limitation that was added or argued during the original prosecution to overcome the prior art "is impermissible recapture (Pannu)". This is not the case with reissue claim 8. The added subject matter is retained in a broader form. Further, the subject matter argued by the applicant and not relating to the added subject matter was not convincing to the examiner, and thus did not result in allowance per se.

The Guidelines also state that if the reissue claim "recites a broader form of the key limitation then the reissue claim may not be rejected under the recapture doctrine (Eggert)". This is analogous to the situation of reissue claim 8.

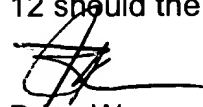
Further, the Guidelines present an equivalent example at Attachment A, page 2, where original claims ABZ were amended in the patent file to include C for allowance (i.e., ABZC was allowed). The reissue claims were directed to ABC, with Z deleted. Thus, "the ABC claims of the reissue are narrower in scope as compared to the canceled-from-the-original-application claim subject matter ABZ in respect to the addition of C ... and there is thus no recapture" (Guidelines, Attachment A, page 3).

For these reasons, the examiner shall no longer pursue the recapture rejection presented in the final Office Action. Thus, the remaining issues are:

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- The 102 rejection of claim 8 over the Kato reference'
- The 103 rejections of claims 9 and 10 over the Kato and Kaneko combination; and
- The 103 rejection of claim 11 over the Kato, Kaneko and Jung combination.

The examiner will continue to entertain the scheduled personal interview on May 12 should the applicant wish to discuss the prior art rejections.



Brian Werner
Primary Examiner
May 4, 2004

BRIAN WERNER
PRIMARY EXAMINER



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
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MEMORANDUM

Date: August 4, 2003

To: Patent Examining Technology Center Directors
Patent Examining Corps

From: *Stephen G. Kunin*
Stephen G. Kunin
Deputy Commissioner for Patent Examination Policy

Subject: Updated Guidance as to Applying the Recapture Rule to Reissue Applications

This memorandum sets forth Office policy for addressing recapture issues in reissue applications, in view of recent case law. The substance of this memorandum will be incorporated into Chapter 1400 of the MPEP in the next revision.

Office policy for addressing reissue recapture issues is set forth in MPEP § 1412.02 - Recapture of Canceled Subject Matter. A recent decision of the Court of Appeals for the Federal Circuit and two recent decisions of the Board of Patent Appeals and Interferences have made it necessary for the Office to revise the existing recapture policy in the Office. These decisions are *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001), *Ex parte Yamaguchi*, 61 USPQ2d 1043 (Bd. Pat. App. & Inter. 2001)(reported but unpublished, precedential), and *Ex Parte Eggert*, Appeal No. 2001-0790 (Bd. Pat. App. & Inter. May 29, 2003)(a precedential opinion of an expanded panel of the Board). Attachment A provides examples where recapture is an issue, and Attachment B is a recapture-analysis flow chart.

The following guidance is provided to assist Office personnel in addressing reissue recapture issues. The guidance provided herein is effective immediately.

I. Summary:

1) The test for determining the presence of recapture or lack thereof is now to be stated in examiners' Office actions to be a three step process. (*Pannu*) The first step is to determine whether, and in what aspect(s), the reissue claims are broader than the patent claims. The second step is to determine whether the broader aspect(s) of the reissued claims relate to surrendered

subject matter. Finally, in the third step, it is to be determined whether the reissued claims were materially narrowed in other respects to avoid the recapture rule.

2) When analyzing a reissue claim for the possibility of impermissible recapture, there are two different types of analysis that must be performed. First, the reissue claim must be compared to any claims canceled or amended during prosecution of the original application. It is impermissible recapture for a reissue claim to be as broad or broader in scope than any claim that was canceled or amended in the original prosecution. Claim scope that was canceled or amended is deemed surrendered and therefore barred from reissue. Second, it must be determined whether the reissue claim entirely omits any limitation that was added/argued during the original prosecution to overcome an art rejection. Such an omission in a reissue claim, even if it includes other limitations making the reissue claim narrower than the patent claim in other aspects, is impermissible recapture. (Painin) However, if the reissue claim recites a broader form of the key limitation added/argued during original prosecution to overcome an art rejection (and therefore not entirely removing that key limitation), then the reissue claim may not be rejected under the recapture doctrine! (Eggert) For example, if the key limitation added to overcome an art rejection was "an orange peel," and the reissue claim instead recites "a citrus fruit peel," the reissue claim may not be rejected on recapture grounds.

a narrower

★

3) The Board (in *Yamaguchi*) has also recently held that an examiner's reasons for allowance statement (as opposed to an examiner's amendment) which identifies a claim limitation as the basis for allowing the original application does not result in that limitation being surrendered, and cannot serve as a basis for recapture. Only an applicant's statement, argument, or amendment (which might be made via an examiner's amendment consented to by applicant) can establish a surrender of claimed subject matter on which to base recapture.

II. Recapture Baseline set by MPEP § 1412.02:

A reissue patent will not be granted to "recapture" claimed subject matter which was "surrendered" to obtain an original patent. As pointed out in MPEP § 1412.02, a patentee cannot recapture, in a reissue application, claims that are of (a) an equal scope, or (b) a broader scope, than the claim subject matter "canceled" from the original application in favor of more specific claims, in order to overcome an art rejection.¹ As further pointed out in MPEP § 1412.02, surrender can occur through arguments alone (without claim amendment in the application) - "surrendered subject matter" will be considered to have "crept into the reissue claim" where the patentee presents in the reissue application a claim that excludes the claim limitation(s) which applicant had argued to

¹ The "cancellation" of claim subject matter can be by deleting the claim and substituting a narrower claim, or by amending the existing claim so that it becomes narrower.

I. Comparison of Reissue Claims narrowed/broadened *vis a-vis* the Canceled Claims

DEFINITION: "Canceled claims," in the context of recapture case law, are claims canceled from the original application to obtain the patent for which reissue is now being sought. The claims

- (1) can simply be canceled and not replaced by others, or
- (2) can be canceled and replaced ² by other claims which are more specific than the canceled claims in at least one aspect (to thereby define over the art of record).

A. Reissue claims are same or broader in scope than canceled claims in all aspects:

The recapture rule bars the patentee from acquiring, through reissue, claims that are in all aspects (a) of the same scope as, or (b) broader in scope than, those claims canceled from the original application to obtain a patent. *In re Ball*, 729 F.2d at 1436, 221 USPQ at 295.

B. Reissue claims are narrower in scope than canceled claims in at least one aspect:

[A preliminary note: If the reissue claims are equal in scope to, or narrower than, the claims of the original patent (as opposed to the claims "canceled from the application") in all aspects, then there can never be recapture. The discussion that follows is not directed to that situation. It is rather directed to the situation where the *reissue claims are narrower than the claims "canceled" from the application in some aspect, but are broader than the claims of the original patent in some aspect.*]

If the reissue claims are narrower in scope than the claims canceled from the original application by inclusion of *the limitation added to define the original application claims over the art*, there will be no recapture, even if the reissue claims are broader than the canceled claims in some other aspect (i.e., an aspect not related to the surrender made in the original application).

Assume combination AB was originally presented in the application, and was amended in response to an art rejection to add element C and thus provide ABC (after which the patent issued). The reissue claims are then directed to combination AB_{broadened}C. The AB_{broadened}C claims are *narrower* in scope when compared with the canceled claim subject matter AB *in respect to the addition of C* (which was added in the application to overcome the art), and there is no recapture.

As another example, assume combination ABZ was originally presented in the application, and was amended in response to an art rejection to add element C and thus provide ABZC (after which the patent issued). The reissue claims are then directed to combination ABC (i.e., element

² The "replacement claims" can be new claims which are narrower than the canceled claims, or can be the same claims amended to be narrower than the canceled version of the claims.

Z is deleted from the canceled claims, while element C remains present). The ABC claims of the reissue are *narrower* in scope as compared to the canceled-from-the-original-application claim subject matter ABZ *in respect to the addition of C* (which was added in the application to overcome the art), and there is thus no recapture.

II. Comparison of Reissue Claims narrowed/broadened *vis a-vis* the Patent Claims

The "patent claims," in the context of recapture case law, are claims which issued in the original patent for which reissue is now being sought. As pointed out above, where the reissue claims are narrower than³ the claims of the original patent in all aspects, then there can never be recapture. Where, however, reissue claims are both broadened and narrowed as compared with the original patent claims, the nature of the broadening and narrowing must be examined to determine whether the reissue claims are barred as being recapture of surrendered subject matter. If the claims are "broader than they are narrower in a manner directly pertinent to the subject matter ... surrendered during prosecution" (*Clement*, 131 F.3d at 1471, 45 USPQ2d at 1166), then recapture will bar the claims. This narrowing/broadening vis-a-vis the patent is broken down into four possibilities that will now be addressed.

Working definition for purposes of this section - *surrender-generating limitation*:

The "limitation" presented, argued or stated to make the claims patentable over the art (in the application) "generates" the surrender of claimed subject matter that omits that limitation in its entirety, i.e., surrender of any claim whose scope does not contain the limitation. For the sake of simplification, this limitation will be referred to throughout this section as the *surrender-generating limitation*. If a claim is presented in a reissue application that omits, in its entirety, the surrender-generating limitation, that claim impermissibly recaptures what was previously surrendered, and that claim is barred under 35 U.S.C. 251. This terminology will be used in the discussion of the four categories of narrowing/broadening vis-a-vis the patent that follows.

- A. **Reissue claims are narrower in scope than patent claims, in area not directed to amendment/argument made to overcome art rejection in original prosecution; are broader in scope by omitting limitation(s) added/argued to overcome art rejection in original prosecution:**

In this case, there is recapture.

This situation is where the patent claims are directed to combination ABC and the reissue claims are directed to ABD. Element C was either a limitation added to AB to obtain allowance of the original patent, or was argued by applicant to define over the art (or both). Thus, addition of C (and/or argument as to C) has resulted in the surrender of any combination of A & B that does not include C; this is the surrendered subject matter. Element D, on the other hand, is not related

³ If reissue claims are equal in scope to the patent claims, there is no recapture as to those reissue claims; but that is self evident, and as such, is not addressed.